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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,427	07/05/2005	Thomas Zelinski	12810-00105-US	6584

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EXAMINER

HANLEY, SUSAN MARIE

ART UNIT	PAPER NUMBER
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1651

MAIL DATE	DELIVERY MODE
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01/03/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/541,427

Applicant(s)

ZELINSKI ET AL.

Examiner

Susan Hanley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 14-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/12/07.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Applicant's election filed 10/12/07 is acknowledged. However, the restriction mailed on 9/13/07 is withdrawn and a new restriction requirement is set forth.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 14-21, 23 and 25-26, drawn to a method for preserving a microorganism having nitrilase activity or reaction thereof in a medium having an aldehyde and composition thereof.

Group II, claim(s) 22, drawn to a preservation solution comprising an aldehyde and a nitrile, hydrocyanic acid or cyanide.

Group III, claim(s) 24, drawn to a foodstuff, feedstuff of chemical,

Group IV, claim(s) 25-26, drawn a method for preparing recombinant, enzymes or fine chemicals.

The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

In the case of Group III, Group III depends from Group II. However, dependency does not necessarily denote that the dependent claim serves to limit the claim from which it depends. Hence, dependent claims can be drawn to a different invention compared to the claim from which it depends. In the instant case, Group II is drawn to a composition comprising an aldehyde and a

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cyanide compound. The invention of Group III is drawn to a compound that is a feedstuff, foodstuff, pharmaceutical or fine chemical. These groups clearly lack a common special technical feature because the two compounds in a solution of Group II are completely separate from a single isolated compound that is not structurally related to the compounds of Group II and has different uses compared to the compounds of Group II.

In the case of comparing Group III to Groups I and IV, the inventions lack a common special technical feature because Kobayashi et al. (FEBS, 1989, cited in the IDS filed 9/8/05) disclose that *Rhodococcus rhodochrous* J1 has nitrilase activity and produces nicotinic acid (p. 349, left col., 2nd paragraph). Nicotinic acid is a pharmaceutical agent for the treatment of pellagra (p. 1126, Taber's Medical Dictionary). Therefore, Kobayashi teaches the special technical feature of the invention of Group III. Although Kobayashi was cited to demonstrate a nitrilase-producing microorganism makes a pharmaceutical product, this is secondary to the claim because the structure and characteristics of nicotinic acid are the same irrespective of its source. Because those claimed embodiments fail to make a contribution over the prior art, it is clear that all claims as filed fail to provide a special technical feature common to all claimed inventions. Because the claims as filed lack a common special technical feature, Group III lacks unity with Groups I and IV.

That groups I, II and IV lack a common special technical feature, and therefore lack of unity, is further demonstrated by the fact that the various products and methods have very different properties, purposes and uses. Group II comprises a solution having two compounds. This invention lacks a special technical feature in common with Groups I and IV because said solution is simply a mixture of chemicals while other said groups require a microorganism which is a complex living organism comprising many different molecules (e.g., lacks DNA, proteins, etc.).

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Group I lacks a special technical feature in common with Group IV. Group I is drawn to a method for preserving a microorganism in a solution having an aldehyde and possibly a cyanide compound. Group IV is drawn to the preparation of products which, in addition to a microorganism, requires the compounds and conditions needed to ferment said microorganism. Group IV also requires an isolation step that is not needed for Group I.

Therefore, Groups I-IV lack a common special technical feature and therefor, lack unity of invention.

Specie Elections

If Group I is elected, Applicant is required to make the following specie elections:

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

I. Applicant is required to elect a specie of microorganisms from claim 20.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an

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allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

Claims 19 and 20 correspond to the species.

The following claim(s) are generic: 14-18, and 21.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The microorganisms have different metabolic and distinguishing features that mark them as belonging to unrelated taxonomic groups.

II. Applicant is required to elect if the method of preparation for claims 25-26 is related to:

- a) a recombinant protein or enzyme; or
- b) a fine chemical; or
- c) a carboxylic and and/or amide.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an

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allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

Claims 25 and 26 correspond to the species.

The following claim(s) are generic: No claim is generic

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The reagents and steps required to prepare a recombinant macromolecules are unrelated to the organic synthetic steps for preparing a fine chemical, which could be anything, or carboxylic acids and/or amides.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

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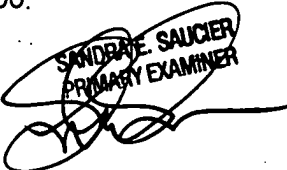
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Hanley whose telephone number is 571-272-2508. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Susan Hanley
Examiner
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SANDRINE SAUCIER
PRIMARY EXAMINER